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Amendment
Attorney Docket No. S63.2N-11056-US03

Remarks

This Amendment is in response to the Office Action dated November 22, 2004. In the Office Action, claims 61, 64, 65 and 68-82 were rejected under 35 USC § 112 as failing to comply with the restriction description requirement. Claims 61, 64, 65 and 68-82 were rejected under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claim 61 was rejected under 35 USC § 102(e) as anticipated by Johnson (5,449,384). Claims 64, 65, 68-73, 76-80, 86 and 87 were rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen et al. (6,582,462) in view of Johnson. Claims 74, 75, 81 and 82 were rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen et al. in view of Johnson and further in view of Marin et al. (5,397,355). Claim 85 was rejected under 35 U.S.C. 102(a) as being anticipated by Pulnev et al. (WO95/17895). Claim 85 was rejected under 35 U.S.C. 102(b) as being anticipated by Savin et al. (4,950,227).

Claims 83 and 84 were previously withdrawn. Applicant reserves the right to prosecute the subject matter of these claims in an application claiming priority from the instant application.

35 USC 112 – First Paragraph

Claims 61, 64, 65 and 68-82 were rejected under 35 USC § 112 as failing to comply with the written description requirement. Claims 61 and 65 have been amended and are fully supported by the written description as well as the drawings, such as for example FIG. 5C.

Withdrawal of the rejection is respectfully requested.

35 USC 112 – Second Paragraph

Claims 61, 64, 65 and 68-82 were rejected under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 61 and 65 have been amended and are believed to comport with 35 USC 112, second paragraph. Claim 65 and claim 76 dependent thereof both use “comprising” language.

Applicant believes claim 76 as previously presented is definite. Nevertheless, to further the prosecution, Applicant has amended the claim to clarify that the struts are arranged in a plurality of serpentine bands. Withdrawal of the rejection is respectfully requested.

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35 USC 102(e)

Claim 61 was rejected under 35 USC § 102(b) as anticipated by Johnson (5,449,384).

Claim 61 has been amended and is directed to an expandable tubular endoluminal prosthesis for maintaining the patency of a bodily vessel, the prosthesis having a flow path therethrough. The claim has also been amended to recite that the prosthesis has struts which, in a cross-section perpendicular to the flowpath, have a greater width than thickness and thicker portions with a narrower portion therebetween.

Johnson is directed to a valve, not an expandable tubular endoprosthesis. Moreover, the Johnson device does not have struts which, in a cross-section perpendicular to the flowpath, have a greater width than thickness. To the contrary, the members of Johnson, as shown in Fig. 15, have a width less than the strut thickness.

For at least these reasons, amended claim 61 overcomes the rejection. Withdrawal of the rejection is respectfully requested.

35 USC 103(a)

Claims 64, 65, 68-73, 76-80, 86 and 87 were rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen et al. (6,582,462) in view of Johnson.

Claims 61, 65, and 86 have been amended to recite in part struts having "a greater width than thickness and thicker portions with a narrower portion therebetween".

There is no disclosure in Anderson that teaches or suggests this limitation. As discussed above, Fig. 15 of Johnson teaches contrary to this limitation. In addition, claims 64 and 65 teach thicker portions with a narrower portion therebetween. There is no suggestion or teaching in either Johnson or Anderson of a strut having a greater width than thickness while at the same time having thicker portions with a narrower portion therebetween. Likewise, regarding claim 86, there is no suggestion or teaching in either Johnson or Anderson of a strut having a greater width than thickness while at the same time having a necked region.

Furthermore there is no teaching or suggestion in Johnson or Anderson that a strut

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as described in Johnson could be suitable in the valve prosthesis of Anderson. Applicant's struts having thicker portions with a narrower portion therebetween are designed to maintain the patency of a bodily vessel. The "grooves" of Johnson are for the purpose of securing leaflets of aortic wall material to the stent by tucking the aortic wall material into the grooves of the struts. This is done outside of the body and is not for the purpose of maintaining the patency of a body vessel. When maintaining the patency of a vessel, it is not desirable to tuck and secure portions of a body lumen into a stent as this would be damaging to the body vessel. As such, one skilled in the art would not look to the grooves of Johnson for designing struts for maintaining the patency of a vessel.

For at least these reasons, claims 61, 65, and 86 and those claims dependent thereof are in condition for allowance. Withdrawal of the rejection is respectfully requested.

35 USC 103(a)

Claims 74, 75, 81 and 82 were rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen et al. in view of Johnson and further in view of Marin et al. (5,397,355). Claims 61 and 65, upon which claims 74, 75, 81, and 82 claim dependence, have been amended to recite in part "thicker portions with a narrower portion therebetween and have a greater width than thickness". As asserted above, Anderson and Johnson do not teach or suggest these limitation. Furthermore, Marin does not provide these missing limitations. For at least this reason, the claims overcome the obviousness rejection. Withdrawal of the rejection is respectfully requested.

35 USC 102(a)

Claim 85 was rejected under 35 U.S.C. 102(a) as being anticipated by Pulnev et al. (WO95/17895).

Claim 85 is directed to an unexpanded stent tapering from the midpoint to each end of the stent at a substantially constant slope in relation to the longitudinal axis. Applicant has reviewed US 6007574, the English language equivalent of WO95/17895. US 6007574 does not disclose that the device of Fig. 3 of Pulnev is unexpanded. It is silent on the issue. Applicant believes, however, in light of the other drawings in the patent, that the device of Fig. 3 is

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expanded. Moreover, the stent of Fig. 3 is described as spherical-shaped. Thus, the slope is not constant and is in fact changing from each point to the next point by definition.

For at least these reasons, the claim overcomes the anticipation rejection.

Withdrawal of the rejection is respectfully requested.

35 USC 102(b)

Claim 85 was rejected under 35 U.S.C. 102(b) as being anticipated by Savin et al. (4,950,227). As discussed above, claim 85 is directed to an unexpanded stent.

The Office Action asserts that:

Savin et. al., in figure 5, disclose an unexpanded stent 16 (The stent is unexpanded since it is not expanded to the condition shown in Fig. 6. Further, the term 'unexpanded' is a product by process limitation.

Applicant disagrees with the assertions of the Office Action. Savin characterizes the stent of Fig. 5 as follows:

Referring to FIGS. 4, 5, 6 and 7, stent delivery system 10 is encased as described above and inserted by standard technique into a body cavity of interest. At this point the stent is positioned (FIG. 4), as required by the physician, and balloon 14 expanded by standard technique (FIGS. 5 and 6). During this expansion, stent 16 is expanded to fill the body duct or cavity. Sleeves 18 and 20 release stent 16, at which point balloon 14 is deflated by standard technique, and catheter 12 and sleeves 18, 20 axially removed from the body cavity. Stent 16 remains in place (FIG. 7).

The Office Action is, therefore, ignoring the patentee's own characterization of Fig. 5 as well as Fig. 4. Although the stent of Fig. 5 is not expanded to the extent that the stent of Fig. 6 is expanded, it is, nevertheless, expanded. Thus, the stent of Fig. 5 of Savin does not anticipate claim 85 in that it is not "unexpanded". For at least this reason the reference is overcome. Withdrawal of the rejection is respectfully requested.

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Conclusion

In light of the above comments, claims 61, 64, 65, 68-82, and 85-87 are believed to be in condition for allowance. Notification to that effect is respectfully requested.

Respectfully submitted,

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